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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,105	04/01/2005	Fabien Astic	NY-GRYN 216-US	9642
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FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			OVANDO, PABLO R	
NEW YORK, NY 10103-3198			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,105	Applicant(s) ASTIC ET AL.	
	Examiner Pablo R. Ovando	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Claim Objections

Claim 19 recites "comprising a indicator", correction to "comprising an indicator" is required for clarification purposes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 16, 19-22, 24, 26-29** are rejected under 35 U.S.C. 102(b) as being anticipated by Murakami et al, US Patent 5,590,178 (hereinafter referenced as Murakami).

As to **claim 16**, Murakami teaches a telephone set comprising a transmitter (fig. 1 telephone 1) for transmitting a request to a server (electronic mail center 3),

said request is a message comprising an identifier of a first telephone set and an identifier of a second telephone set in telephone communication with said first telephone set (col. 5, lines 23-35, the telephone number of the calling party and called telephone number is sent to the electronic mail center); and

wherein said server comprises a database (fig. 1, external storage 33) for storing identifiers of telephone sets and identifiers of multimedia terminals associated with said telephone sets (col. 5, lines 36-40), and a transmitter (note that the transmitter is inherent, since the phone is transmitting messages as taught in col. 5, lines 25-29) for transmitting to a multimedia terminal associated with said first telephone set and/or said second telephone set an identifier of other multimedia terminal to establish a multimedia communication between said multimedia terminals via a logical channel distinct from a telephone communication channel between said first telephone set and said second telephone set (col. 5, lines 43-51 and col. 6, lines 3-15, note that a connection is established via network 1 between terminal 2-A and terminal 2-B).

As to **claim 19**, Murakami teaches an indicator for indicating whether said multimedia communication can be initiated (col. 6 lines 3-10, the fact that a communication with the terminal is established is an indication that communication can be initiated).

As to **claim 20**, Murakami teaches a transmitter (note that the transmitter is inherent, since the phone is transmitting messages as taught in col. 5, lines 25-29) for

transmitting to a server, a recorded message containing an identifier of a telephone set and an identifier of a multimedia terminal associated with said telephone set (col. 8 lines 18-24, col. 8 lines 31-37).

As to **claim 21**, Murakami teaches a server (fig. 1 electronic mail center 3), said server comprising a database for storing said identifiers of said telephone sets and said identifiers of said multimedia terminals associated with said telephone sets (fig. 1 external storage 33).

As to **claim 22**, Murakami teaches a server comprising a database (external storage 33) for storing identifiers of telephone sets and identifiers of multimedia terminals associated with said telephone sets (col. 5 lines 37-51) and a transmitter for transmitting to a first multimedia terminal associated with a first telephone set an identifier of a second multimedia terminal associated with a second telephone set via a logical channel to establish a multimedia communication between said first multimedia terminal and said second multimedia (col. 5 lines 43-50 and col. 6 lines 3-10) terminal in response to a request from said first or second telephone set via a telephone channel (col. 5 lines 23-35), and wherein said logical channel is distinct from said telephone channel (network 1 and telephone exchange 6).

As to **claim 24**, Murakami teaches receiver for receiving a recorded message comprising an identifier of a multimedia terminal and an identifier of an associated telephone set, and wherein said database is operable to record said identifiers (col. 8 lines 18-24 and col. 8 lines 31-37).

As to **claim 26**, Murakami teaches a multimedia terminal (fig. 1 terminal 2-A) comprising a device for establishing a multimedia communication with another multimedia terminal in response to a request from said server of claim 22 (col. 5 lines 43-51 and col. 6 lines 3-10).

As to **claim 27**, Murakami teaches a transmitter for transmitting to said server a recorded message, wherein said recorded message comprises an identifier of said multimedia terminal and an identifier of an associated telephone set (col. 8 lines 17-25, col. 31 lines 31-36).

As to **claim 28**, Murakami teaches a database for storing identifiers of telephone sets and identifiers of multimedia terminals associated with said telephone sets (col. 8 lines 17-24).

As to **claim 29**, Murakami teaches a method of initiating multimedia communications between multimedia terminals associated with telephone sets via a logical channel distinct from a telephone communications channel (fig. 1 network 1, fig. 1 telephone exchange 6), comprising the steps of:

sending a request comprising identifiers of a first and a second telephone sets to a server by said first telephone set or said second telephone set (col. 5 lines 23-41);

determining identifiers of a first and a second multimedia terminals associated with said identifiers of said first and said second telephone sets from a database by said server; and (col. 5 lines 36-48)

transmitting at least one of the following by said server: a message to said first multimedia terminal comprising said identifier of said second multimedia terminal or a message to said second multimedia terminal comprising said identifier of said first multimedia terminal (col. 5 lines 52-58 and col. 6 lines 3-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 17, 18, 23, 25 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami and in further view of Begis, US Patent 6,907,034 (hereinafter referenced as Begis).

As to **claim 17**, Murakami teaches everything claimed, as applied to claim 16. However, Murakami does not teach that the logical channel is an IP channel. Begis teaches the use of an internet network 125 to connect data which is simultaneously connected to the telephone communication over PSTN 130 (col. 3 lines 1-15). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teachings of Begis in Murakami for the purpose of implementing a network compatible with IP devices. Additionally an IP network can increase the speed of the connectivity and reduce costs.

As to **claim 18**, Begis teaches that the message is at least one of the following: a short message service (SMS), enhanced message service (EMS) or dual tone multi-frequency (DTMF) message (col. 3 lines 15-21).

As to **claim 23**, Begis teaches the use of an internet network 125 to connect data which is simultaneously connected to the telephone communication over PSTN 130 (col. 3 lines 1-15).

As to **claim 25**, Begis teaches receiving requests from telephone sets via at least one of the following: short message service (SMS), enhanced message service (EMS) or dual tone multi-frequency (DTMF) channels (col. 3 lines 15-21).

As to **claim 30**, Begis teaches initiating multimedia communications of claim 29, wherein the logical channel is an IP channel (fig. 1 internet 125); and wherein said first and said second multimedia terminals establish multimedia communications over said IP channel (col. 3 lines 1-10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo R. Ovando whose telephone number is 571-272-9752. The examiner can normally be reached on M-F 7:30 am to 5:00pm, EST, Alternating Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.O.


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700